

REMARKS

Reconsideration And Allowance Are Respectfully Requested.

Claims 1-41, 52-60 and 62 are currently pending. Claim 61 has been canceled and replaced with new claim 62. No other claims have been amended. No new matter has been added. Reconsideration is respectfully requested. The amendment and remarks are not believed to require undue consideration and relate to issues previously discussed during the prosecution of the present application.

Applicant would first like to thank Examiner Passaniti for indicating the fact that claims 1-41 and 52-61 appear to be allowable over the prior art of record.

However, the Examiner has indicated that claims 52-61 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. The Office Action is correct in stating that Applicant may not recapture subject matter intentionally given up during the prosecution of a patent application. However, the facts of the present reissue application do not support such a conclusion.

Specifically, claim 52 defines a golf club shaft very different from the shafts considered during the prosecution of the original application. Claim 52 is narrower in many respects than the claims originally considered and as such is not believed to constitute a recapture of subject matter given up during prosecution of the present application. For example, claim 52 defines "a tubular section including a first end located at the butt end of the golf club shaft and

[a] second end positioned slightly short of the distal end of the golf club shaft”. The original application makes no distinction as to the first end and second end of the tubular section. Presumably, the decision not to include such limitations in the original claims was based upon a desire not to specifically define the position at which the insert must be secured to the shaft; that is, the insert of the originally filed claims could have been secured adjacent the grip or adjacent the club head, while new reissue claim 52 specifically requires that the insert be positioned adjacent the second end of the shaft at a position adjacent the golf club head.

New reissue claim 52 is further narrower than the originally filed claims in that it includes limitations related to “the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball”. This limitation is material to the error which occurred during the prosecution of the original patent application. That is, Applicant failed to appreciate the patentable significance of positioning an insert at the second end of a golf club shaft for achieving vibration absorbance.

In addition to the narrowing limitations added to new reissue claim 52, reissue claim 52 does not include various limitations added during the prosecution of the present application. For example, reissue claim 52 does not include limitations regarding the rigidity of the insert or the unitary nature of the insert. These features do not relate to the error

which occurred during the original prosecution as they have no bearing on an insert formed from a vibration absorbing material which is secured at a second end of the golf shaft adjacent the club head.

Courts have previously considered situations such as the present wherein a reissue claim is broader in some respects and narrower in other respects. In fact, courts have rejected the contention that if a reissue claim is broader in any respect, it necessarily should be deemed broader in all respects and the recapture rule should apply. *Ball Corp. v. United States*, 759 F.2d 1429, 1438, 221 U.S.P.Q. 289, 296. (Fed. Cir. 1984). The Federal Circuit, however, limited its decision to situations where the broader aspect of the claim “is not material to the alleged error supporting reissue”. *Id.*

Considering the broadened limitations of reissue claim 52, it becomes clear that these limitations are not material to the error supporting reissue. Specifically, the error supporting reissue relates to Applicant’s failure to appreciate the significance of securing a vibration absorbing insert to the second end of a golf club shaft adjacent the club head. The inclusion of a “unitary insert” or an insert which is “more rigid” than the tubular section are irrelevant to the alleged error supporting reissue and the recapture rule should not be applied as specified by the Federal Court in *Ball Corp.* Regardless of whether the broadened limitations relating to reissue claim 52 are material, the U.S. Claims Court, in evaluating *Ball Corp.*, determined “that the recapture rule should not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when, as is potentially the case here, the reissue claim is narrower than the canceled claim in a way that is material to the “error”“. *Patecell v.*

United States, 16 Cl.Ct. 644, 652, 12 U.S.P.Q. 2d 1440 (Cl.Ct. 1989). The Court in *Patecell* based their decision on the fact that the crucial issue in assessing the significance of narrowing claim limitations on the existence of an error in a reissue application is the intent of the applicant when he or she amended the claim in a narrowing manner. *Ball Corp.*, 729 F.2d at 1436, 221 U.S.P.Q. at 295. However, the Court in *Patecell* reasoned that

“when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee’s intent [that is, whether the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable] and, hence, as to the absence of ‘error’ cannot be made based exclusively on a comparison of the reissue claim with the canceled claim. Under the patent laws, the fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrow in some respect necessarily also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim being patentable ... Therefore one cannot presume merely from the act of canceling a claim that a patent applicant made a deliberate judgment that a second claim that is narrower in a certain respect than the canceled claim also would be unpatentable....The conclusion should not change when a second claim, while narrower in at least one respect, is also broader in some respect. The applicant may have agreed with the patent examiner that some original claim was unpatentable but may not have considered, when canceling the claim, that the

claim could have been rendered patentable by the addition of a particular limitation. Hence, a deliberate decision to cancel a particular claim because it is unpatentable would not necessarily constitute a deliberate judgment that a claim that is broader in some ways and narrower in others also would be unpatentable.”

Patecell, 16 Cl.Ct. 644 at 653.

The Court in *Patecell* describes exactly what happened in the present situation. Specifically, the originally filed claims were amended in an effort to overcome rejections based upon prior art. However, Applicant did not appreciate the significance of the insert position as it may relate to a vibration absorbing element in the golf club shaft. The fact that Applicant amended the original claims in an effort to overcome prior art should, therefore, have no bearing on whether the narrower reissue claim would have similarly been addressed by the Applicant.

It is, therefore, Applicant’s opinion that the recapture rule does not apply to claims 52-61 and Applicant respectfully requests that the rejection thereof be withdrawn.

As to the objection relating to claim 61, Applicant has cancelled claim 61 and added new claim 62. This claim is substantially identical to original claim 61 and Applicant respectfully requests that the rejection be withdrawn.

Further, and with reference to the filing of a supplemental oath or declaration, Applicant respectfully requests that the filing be held in abeyance until a final determination is made as to the allowable nature of claims 52-61.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made".

Applicant respectfully requests consideration of the preceding remarks and entry of this amendment. If the Examiner believes an interview would be helpful in expediting the prosecution of the present application, he is urged to contact the undersigned at (703) 920-1122.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard N. Flaxman", with a stylized flourish at the end.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Cancel claim 61.

Add new claim 62 as follows:

62. The golf club shaft according to claim 42, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length.